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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,234	10/30/2000	Otto Preiss	004501-446	6329

21839 7590 02/22/2005

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EXAMINER

BARNES, CRYSTAL J

ART UNIT	PAPER NUMBER
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2121

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/698,234

Applicant(s)

PREISS ET AL.

Examiner

Crystal J. Barnes

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-9, 11 and 14-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4, 5, 7, 9, 11, 16, 18 and 20-22 is/are rejected.
- 7) ☒ Claim(s) 2, 3, 6, 8, 14, 15, 17 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a Non-Final Office Action in response to the Appeal Brief received on 20 December 2004. Claims 2-9, 11 and 14-22 are pending in this application.

Response to Arguments

2. In view of the Appeal Brief filed on 20 December 2004, PROSECUTION IS HEREBY REOPENED. New grounds of rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Specification

3. The disclosure is objected to because of the following informalities:
reference to claims on page 1 lines 14-15 should be removed. Appropriate
correction is required.

Claim Objections

4. Claims 5 and 11 are objected to because of the following informalities: the
IEC Standard should be referred to specifically by name not by number.
Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102
that form the basis for the rejections under this section made in this Office
action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in
public use or on sale in this country, more than one year prior to the date of application for patent in
the United States.

6. Claims 4, 5, 7, 11, 16, 18, 21 and 22 are rejected under 35 U.S.C. 102(b) as
being anticipated by USPN 5,793,963 to Tapperson et al.

As per claim 21, the Tapperson et al. reference discloses a method for integration of a field device in an installation control system, wherein the installation control system has a communications network and a control station, the method comprising a) transmitting (see column 4 lines 59-62, "transmitted"), by the field device (see column 7 lines 56-63, "Fieldbus field devices"), a functional description (see column 4 lines 59-62, "secondary information") of its device functions ("secondary information") to the control station (see column 7 lines 56-63, "control room 128") in a standardized form ("Fieldbus control networks 138, 140"); b) installing functions (see column 8 lines 27-31, "access to all functions") associated with the field device ("Fieldbus field devices") on the control station ("control room 128"); and c) configuring communications links (see column 8 lines 4-16, "bridge/converter 136") between the device functions ("secondary information") and functions of the control station ("control room 128").

As per claim 22, the rejection of claim 21 is incorporated and further claim 22 contains limitations recited in claim 21; therefore claim 22 is rejected under the same rationale as claim 21.

As per claim 4, the Tapperson et al. reference discloses at least one function of the control station ("control room 128") is installed automatically on

the basis of the nature of this function (see column 5 lines 59-61, "primary functions").

As per claim 16, the rejection of claim 4 is incorporated and further claim 16 contains limitations recited in claim 4; therefore claim 16 is rejected under the same rationale as claim 4.

As per claim 5, the Tapperson et al. reference discloses the functional descriptions of the field device use a description language in accordance with IEC Standard 61850-6 or its draft (see column 2 lines 44-56, "Fieldbus protocol").

As per claim 11, the rejection of claim 5 is incorporated and further claim 11 contains limitations recited in claim 5; therefore claim 11 is rejected under the same rationale as claim 5.

As per claim 7, the Tapperson et al. reference discloses functions of the control station ("control room 128") that are associated with the field device ("Fieldbus field devices") are transmitted by the field device ("Fieldbus field devices") to the control station ("control room 128") during a physical installation (see column 8 lines 1-3, "added") of the field device ("Fieldbus field devices").

As per claim 18, the rejection of claim 7 is incorporated and further claim 18 contains limitations recited in claim 7; therefore claim 18 is rejected under the same rationale as claim 7.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,793,963 to Tapperson et al.

As per claim 9, the Tapperson et al. reference does not expressly disclose the installation control system (see column 7 lines 56-63, "DCS 126") controls a high-voltage or medium-voltage switchgear assembly.

However, it would have been logically to one of ordinary skill in the art to modify the distributed control system to be applicable to any system interconnecting field equipment such as sensors, actuators, controllers, valves, etc. located in a process control environment of a plant.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the distributed control system taught by the

Tapperson et al. reference to be applicable to any system interconnecting field equipment to provide a local area network for field devices within a plant, enabling these field devices to interoperate to perform control functions at locations distributed throughout the plant and to communicate with one another to implement an overall control strategy.

One of ordinary skill in the art would have been motivated to provide a local area network for field devices within a plant, enabling these field devices to interoperate to perform control functions at locations distributed throughout the plant and to communicate with one another to implement an overall control strategy so that smart field devices that use a standard communication protocol are interfaced to a distributed control system which may not use that communication protocol.

As per claim 20, the rejection of claim 9 is incorporated and further claim 20 contains limitations recited in claim 9; therefore claim 20 is rejected under the same rationale as claim 9.

Allowable Subject Matter

9. Claims 2, 3, 6, 8, 14, 15, 17 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following reference is cited to further show the state of the art with respect to device management in general:

US Pub. No. 2004/0194101 A1 to Glanzer et al.

Ron W Bijoch, "Adopting a standard: How ICCP works for NSP",

Transmission & Distribution World, Overland Park, Dec 1998,

volume 50, issue 13, page 26 (3 pages).

N. P. Mahalik et al., "Fieldbus technology based, distributed control in

process industries: a case study with LonWorks Technology",

Integrated Manufacturing Systems, Bradford, 1997, volume 8,

issue 4, page 231.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Crystal J. Barnes whose telephone number is 571.272.3679. The examiner can normally be reached on Monday-Friday alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 571.272.3687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CJB
11 February 2005


Anthony Knight
Supervisory Patent Examiner
Group 3600